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10/630,372	07/30/2003	Anil Kumar Goel	14618-009001	8958

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REALNETWORKS, INC. C/O STOEL RIVES LLP  
201. S MAIN STREET, SUITE 1100  
SALT LAKE CITY, UT 84111

EXAMINER
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RIVIERE, HEIDI M

ART UNIT	PAPER NUMBER
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3689

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02/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/630,372	<b>Applicant(s)</b> GOEL, ANIL KUMAR	
	<b>Examiner</b> HEIDI RIVIERE	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on **5 December 2008** has been entered.

***Response to Arguments***

2. Applicant's arguments with respect to **claims 1-36** have been considered however they are not persuasive. Examiner used **Marsh et al. (US 6,574,465 B2)** (hereinafter "**Marsh**") in view of **Gilliam et al. (US 7,206,765 B2)** (hereinafter "**Gilliam**") to reject **claims 1-36**. Applicant argues that "Gilliam is not understood to describe or suggest determining an upgrade cost, based at least in part upon value associated with a list of authorizations possessed by the user". However, the Marsh reference is noted as citing upgrade cost and information for wireless communication plans. Please note the following as presented below in the 35 U.S.C. 103 rejection, "Determining an upgrade cost associated with each of the identified upgrade packages, based at least in part upon a value associated with a list of authorizations possessed by the user; (Marsh: col. 7, line 22- col. 8, line 50 – when plan choices are evaluated a user stored information is reviewed; for

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example, “zip codes, symbolic of where the user can purchase service (at least their home zip code and possibly one or more zip codes of locations for the user’s place of employment) from the user profile are used to find packages”; packages are organized from lowest cost to highest cost”. Therefore the rejection is not withdrawn.

3. **Claims 1 and 18** were rejected under 35 U.S.C. 101 for lacking utility. The amended claims have been reviewed and the rejection withdrawn.

4. **Claims 1 and 18** were also rejected under 35 USC 112, paragraph 2. Examiner has considered Applicant’s arguments. However, there continues to be missing steps in the limitations and therefore, the rejection is not withdrawn but remains applied to claims 1-36.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-36** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are still missing a key step. For example, Claim 1 discloses "determining if the user has access to the data source" and then the limitations jump to the step "in response to the user being denied access to the data source". It remains unclear who or what denies the user from access to the data source or how this information is obtained.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Marsh et al. (US 6,574,465 B2)** (hereinafter "**Marsh**") in view of **Gilliam et al. (US 7,206,765 B2)** (hereinafter "**Gilliam**").

5. **With respect to claims 1, 18, 35 and 36: (Currently Amended)** Marsh teaches:

- Electronically receiving information indicative of a request by a user for access to a data source; (Marsh: col. 1, lines 50-67; col. 5, line 10-20 and line 64 to col. 6, line 25 – “wireless communication data received from... the client ...in order to determine the optimal wireless communication service plans”; “at least one transceiver that is configured to receive billing information associated with a subscriber”; input device used to input data from user”)
- Determining an upgrade cost associated with each of the identified upgrade packages, based at least in part upon a value associated with a list of authorizations possessed by the user; (Marsh: col. 7, line 22- col. 8, line 50 – when plan choices are evaluated a user stored information is reviewed; for example, “zip codes, symbolic of where the user can

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- purchase service (at least their home zip code and possibly one or more zip codes of locations for the user's place of employment) from the user profile are used to find packages"; packages are organized from lowest cost to highest cost)
- in response to the user being denied access to the data source identifying one or more upgrade packages that would allow the user to access the data source. (Marsh: col. 8, lines 28-42; col. 9, lines 31-53; col. 17, lines 53-67; col. 18, Tables 6-7 - MAMBA system and the decide Plan process determines if a group of subscribers is not on the optimal service plan for whatever reason and suggest alternative cellular service plans; plan package options sorted by cost).

Marsh does not teach, however as best understood by Examiner, Gilliam teaches determining if the user has access to the data source; (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 31-46; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Marsh and Gilliam. Marsh teaches a system and method for determining optimal wireless communication service plans. The system analyzes wireless communication data while receiving, storing subscriber related information. The marsh system also suggests alternative plans to clients as well as listing cost per package information from lowest cost to highest cost. Gilliam teaches a method for supplying and

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managing usage rights based on rules. System determines if user is granted or denied use of item.

6. **With respect to claims 2 and 19:** Marsh teaches the limitations cited in the rejections above. Marsh does not teach, however Gilliam teaches maintaining a datastore that defines the authorizations possessed by one or more users. (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 31-46; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item ).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Marsh and Gilliam. Marsh teaches a system and method for determining optimal wireless communication service plans. The system analyzes wireless communication data while receiving, storing subscriber related information. The marsh system also suggests alternative plans to clients as well as listing cost per package information from lowest cost to highest cost. Gilliam teaches a method for supplying and managing usage rights based on rules. System determines if user is granted or denied use of item.

7. **With respect to claims 3 and 20: (Previously Presented)** Marsh teaches the limitations cited in the rejections above. Marsh does not teach, however Gilliam teaches access to the data source is granted if a user possesses a specific authorization. . (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 31-46; col. 41, line 60 – col. 4, lines 3 – digital rights management system

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can reference, call or locate item associated with rights offer; user can be denied use of item ).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Marsh and Gilliam. Marsh teaches a system and method for determining optimal wireless communication service plans. The system analyzes wireless communication data while receiving, storing subscriber related information. The marsh system also suggests alternative plans to clients as well as listing cost per package information from lowest cost to highest cost. Gilliam teaches a method for supplying and managing usage rights based on rules. System determines if user is granted or denied use of item.

8. **With respect to claims 4 and 21:** Marsh teaches the limitations cited in the rejections above. Marsh does not teach, however Gilliam teaches determining if a user has access includes: accessing a datastore record to obtain a list of authorizations possessed by the user. (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 24-46; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item; users rights embodied in license).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Marsh and Gilliam. Marsh teaches a system and method for determining optimal wireless communication service plans. The system analyzes wireless communication data while receiving, storing subscriber related information. The marsh system also suggests

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alternative plans to clients as well as listing cost per package information from lowest cost to highest cost. Gilliam teaches a method for supplying and managing usage rights based on rules. System determines if user is granted or denied use of item.

9. **With respect to claims 5 and 22:** Marsh teaches the limitations cited in the rejections above. Marsh does not teach, however Gilliam teaches: comparing the list of authorizations possessed by the user to the specific authorization required to access the data source; wherein the user is denied access to the data source if the list of authorizations possessed by the user does not include the specific authorization required to access the data source. (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 24-46; col. 30, lines 26-35; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item; users rights embodied in license; comparison module compares rights).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Marsh and Gilliam. Marsh teaches a system and method for determining optimal wireless communication service plans. The system analyzes wireless communication data while receiving, storing subscriber related information. The marsh system also suggests alternative plans to clients as well as listing cost per package information from lowest cost to highest cost. Gilliam teaches a method for supplying and managing usage rights based on rules. System determines if user is granted or denied use of item.

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10. **With respect to claims 6 and 23:** Marsh teaches the limitations cited in the rejections above. Marsh does not teach, however Gilliam teaches maintaining a datastore that defines a plurality of data source packages, wherein each data source package includes one or more authorizations for data sources. (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 24-46; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item; users rights embodied in license).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Marsh and Gilliam. Marsh teaches a system and method for determining optimal wireless communication service plans. The system analyzes wireless communication data while receiving, storing subscriber related information. The marsh system also suggests alternative plans to clients as well as listing cost per package information from lowest cost to highest cost. Gilliam teaches a method for supplying and managing usage rights based on rules. System determines if user is granted or denied use of item.

11. **With respect to claims 7 and 24:** Marsh teaches determining which of a plurality of data source packages includes a specific authorization required to access the data source, thus generating a list of upgrade packages. (Marsh: col. 8, lines 28-42; col. 9, lines 31-53; col. 17, lines 53-67; col. 18, Tables 6-7 - plan package options sorted and listed by cost).

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12. **With respect to claims 8 and 25:** Marsh teaches the list of upgrade packages includes one or more discrete data source packages. (Marsh: col. 8, lines 28-42; col. 9, lines 31-53; col. 17, lines 53-67; col. 18, Tables 6-7 - plan package options sorted and listed by cost).

13. **With respect to claims 9 and 26:** Marsh teaches the list of upgrade packages includes one or more premium data source packages. (Marsh: col. 8, lines 28-42; col. 9, lines 31-53; col. 17, lines 53-67; col. 18, Tables 6-7 - plan package options sorted and listed by cost).

Furthermore, the data identifying types of data source packages is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between

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the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data identifying the selectable options and the information displayed upon selection of each option adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying types of data source packages does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

14. **With respect to claims 10 and 27:** Marsh discloses determining an upgrade cost for each of the upgrade packages. (Marsh: col. 8, lines 28-42; col. 9, lines 31-53; col. 17, lines 53-67; col. 18, Tables 6-7 - plan options sorted by cost).

15. **With respect to claims 11 and 28:** Marsh discloses sorting the list of upgrade packages based on the upgrade cost associated with each of the

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upgrade packages. (Marsh: col. 8, lines 28-42; col. 9, lines 31-53; col. 17, lines 53-67; col. 18, Tables 6-7 - plan options sorted by cost).

16. **With respect to claims 12 and 29:** Marsh discloses sorting the list of upgrade packages based on a profit margin associated with each of the upgrade packages. (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7; col. 33, lines 8-19 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost).

17. **With respect to claims 13 and 30:** Marsh discloses sorting the list of upgrade packages based on a predetermined marketing preference. (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; plan options sorted by cost).

18. **With respect to claims 14 and 31:** Marsh discloses:

- determining an undiscounted cost for an upgrade package; (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost) and
- discounting the undiscounted cost based on a value associated with a list of authorizations possessed by the user. (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 19, Table 8

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and line 60 – col. 20, line 6 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost and also factors in discounts).

19. **With respect to claims 15 and 32:** Marsh discloses:

- determining an undiscounted cost for an upgrade package; (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost) and
- discounting the undiscounted cost based on a promotional discount. (Marsh: col. 7, lines 30-39 – promotions taken into consideration when selecting optimal service plans).

20. **With respect to claims 16 and 33:** Marsh discloses determining an upgrade cost for each of the upgrade packages includes determining which of the upgrade packages requires one or more prerequisite data source packages. (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; plan options sorted by cost).

21. **With respect to claims 17 and 34:** Marsh discloses:

- determining an undiscounted cost for an upgrade package that requires one or more prerequisite data source packages; (Marsh:

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col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost).

- increasing the undiscounted cost based on a cost associated with the one or more prerequisite data source packages; (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 19, Table 8 and line 60 – col. 20, line 6 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost and also factors in discounts) and
- discounting the undiscounted cost based on a value associated with a list of authorizations possessed by the user. (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 19, Table 8 and line 60 – col. 20, line 6 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost and also factors in discounts).

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## **CONCLUSION**

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. R./  
Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
2/13/09

